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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,719	07/25/2001	James A. Parker		6795

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LOUIS J. HOFFMAN, P.C.
14614 NORTH KIERLAND BOULEVARD, SUITE 300
SCOTTSDALE, AZ. 85254

EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,719

Applicant(s)

PARKER, JAMES A.

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29-33, 37, 38 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 16-21 and 44 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 22-27, 29-33, 37, 38 and 45-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 04/080/05. These drawings are not acceptable. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings (Fig. 2) are hand-drawn and therefore informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 14, 15, 22-27, 29-33, 37, 38, 44-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Regarding claims 14 and 45-48, "A data storage medium comprising indicia of instructions for a processor to perform a method for managing access to a file, via an electronic message, the method comprising: displaying...; designating...; transmitting...; and...transmitting..." would normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media

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incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

5. Regarding claim 15, "A system for managing access, via an electronic message, to a file maintained within a first domain, the system comprising: means for identifying...; and means for transmitting..." is non-statutory, since it is not tangibly embodied in a manner so as to be executable, as the only hardware is in an intended use statement. This is true even if the various means include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware. Additionally, Applicant defines such various means as software modules, and therefore the various means are not tangibly embodied (see Specification, p. 5, paragraph [0022]).

6. Regarding claims 22-24, "A data storage medium comprising indicia of instructions for a processor to perform a method...the method comprising: causing...; and causing..." would normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

7. Regarding claim 25, "An electronic message system comprising: an electronic message program...; means for causing..." is non-statutory, since it is not tangibly

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embodied in a manner so as to be executable, as the only hardware is in an intended use statement. This is true even if the recited program and means include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware. Additionally, Applicant defines such means as software modules, and therefore the various means are not tangibly embodied (see Specification, p. 5, paragraph [0022]).

8. Regarding claims 26-27, "A propagated signal embodied in a message-encoded data stream having a series of data frames..." is non-statutory as not being tangibly embodied in a manner so as to be executable.

9. Regarding claims 49-52, "A data storage medium comprising indicia of instructions for processor to perform a method for managing access, via an electronic message, to a file maintained within a first domain, the method comprising..." would normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma.

12. Yamaguchi disclosed a method and system for managing access, via an electronic message, to a file maintained within a first domain, the system comprising means for identifying addresses of one or more recipients of the message (see paragraph [0052], [0068]) and designating each recipient as having viewing or editing privileges of the file (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); and means for transmitting the electronic message to the recipients within one or more domains distinct from the first domain such that any recipients designated as file viewers and recipients designated as file editors can access the file, and any recipients designated as file editors can modify the file (see paragraph [0069], [0103]).

13. While Yamaguchi disclosed transferring the electronic message to the recipients, Yamaguchi did not specifically disclose transmitting the electronic message without transferring the file out of the first domain with the electronic message.

14. In a related art of electronic messaging, Kuzma disclosed a method and system for transmitting e-mail over a network. Kuzma disclosed sending attachment files by reference, wherein the e-mail message itself comprised an attachment reference such

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as a hyperlink (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33).

Thus, Kuzma disclosed transmitting attachment data separately from an e-mail message.

15. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for identifying recipients of an electronic message as having viewing/editing privileges, transmitting the electronic message to the recipients without transferring the file with the electronic message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits.

16. Claims 29-33, 37, 38, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma.

17. Yamaguchi disclosed a method and system comprising accepting one or more file accessor addresses (see paragraph [0052], [0068]); for each address, determining an authorization status as either authorized for direct file access or not authorized for direct file access (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); transmitting the electronic message to the addresses within at least a second domain distinct from the first domain (see paragraph [0069], [0103]); and for each electronic message sent to a file accessor address not so authorized, transferring data of the file as an attachment to the electronic message (see paragraph [0069]).

18. Yamaguchi did not specifically disclose for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message.

19. In a related art of electronic messaging, Kuzma disclosed a method and system for transmitting e-mail over a network. Kuzma disclosed sending attachment files by reference, wherein the e-mail message itself comprised an attachment reference such as a hyperlink (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33). Thus, Kuzma disclosed transmitting attachment data separately from an e-mail message.

20. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for displaying an e-mail message window comprising a plurality of recipients fields for recording which recipient addresses were authorized to view an attachment or edit the attachment, including the provision for transmitting the attachment separately from the

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e-mail message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits.

Claim Objections

21. Claim 49 is objected to because of the following informalities: recitation of "instructions for processor" is not grammatically correct and appears to be a typographical error. Appropriate correction is required.

Allowable Subject Matter

22. Claims 1-13, 16-21, and 44 are allowed.

23. The following is an examiner's statement of reasons for allowance:

24. The provision for managing access, via an electronic message, to a file maintained within a first domain, comprising displaying an electronic message window comprising a first field, a second field, and a third field; accepting message addresses

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by performing at least one of recording, in the first field, indicia identifying one or more addresses to which the electronic message is to be transmitted, recording, in the second field, indicia identifying one or more addresses of viewers authorized to view the file, and recording, in the third field, indicia identifying one or more addresses of editors authorized to modify the file; transmitting the electronic message to the addresses recorded in the first field; and transmitting data of the file separately from the electronic message upon request by a viewer authorized to view or modify the file is not fairly taught or suggested by the prior art of record. Support for this functionality can be found in the Specification, paragraphs [0009], [0076]-[0091]; Fig. 4, 5.

25. The provision for modifying operation of an electronic message program that displays a message window including a message recipient field and a file identification field and generates an electronic message for transmission to one or more persons, the method comprising causing the message window to further include a file viewer field and a file editor field; and causing the electronic message program to include, in the electronic message, indicia identifying any address identified in the file viewer field as belonging to recipients having viewing privileges of a file identified in the file identification field, and identifying any addresses identified in the file editor field as belonging to recipients having editing privileges of the file is not fairly taught or suggested by the prior art of record. Support for this functionality can be found in the Specification, paragraphs [0054], [0075]-[0078], Fig. 4-6.

26. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

27. Applicant's arguments filed 04/25/05 have been fully considered but they are not persuasive.

28. Examiner acknowledges Applicant's amendment to the Specification. Previous objections to the Specification have been overcome by the amendment and have been withdrawn.

29. Examiner acknowledges Applicant's amendment to the Drawings. The amendment to the Drawings is not acceptable as they appear to be hand-drawn and are therefore informal.

30. Regarding claims 1-8, 10-20, 22-37, and 39-43 previously rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Pat. No. 6,275,848), and further in view of Yamaguchi et al. (U.S. Pat. App. Pub. 2002/005382), Examiner submits that the rejection has been withdrawn.

31. Regarding claims 1-8, 10-20, 22-37, and 39-43 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma, Examiner has withdrawn the rejection of claims 1-8, 10-14, 16-20, 22-27 under these grounds of rejection. Examiner maintains the rejection of claims 15, 29-33, 37, 38, and 49-52 under these grounds of rejections.

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Examiner submits that the broad concept of "designating each recipient as having viewing or editing privileges" as asserted by Applicant regarding claim 15 is clearly taught by Yamaguchi where it was disclosed that a recipient had different viewing/editing rights to an attachment based on which field (TO, CC, BCC) the recipient was designated to (see paragraphs [0066]-[0069]). Examiner further submits that transferring data of a file "as an attachment" as asserted by Applicant regarding claim 29 is clearly taught by Yamaguchi where it was disclosed that an electronic mail could be generated with an attached file capable of being edited (see paragraph [0066]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paleiov et al. (U.S. Pat. App. Pub. 2002/0138586)

Beyda et al. (U.S. Pat. No. 6,505,237)

Kawanaka (U.S. Pat. No. 6,351,763)

Greenstein (U.S. Pat. No. 6,266,692)

Mastrianni (U.S. Pat. App. Pub. 2002/0116641)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization, where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER